

R E M A R K S

The specification was amended for the reasons discussed hereinbelow.

Claims 5 to 8 were amended to include the features of claims 9 to 12, respectively.

Claim 31 was amended to include the feature of claim 32.

The amendments to claims 18, 21, 24 and 27, and new claims 33 and 34 are supported by the last paragraph on page 28 of the specification.

New claims 35 to 42 are supported in the specification by Table 4 at the bottom of page 25 of the specification.

Applicants are pleased to note that the claims are free of any prior art rejections.

Concerning the first two paragraphs on page 3 of the Office Action, it is noted that the specification defines "SHODEX ASAHIPAK" C8P 50 4E as a high performance liquid chromatography ("HPLC") column (see, for example, the specification on page 5, line 9 from the bottom). Therefore, the originally filed specification sets forth the generic terminology requested by the Examiner. Following the Examiner's request, pages 3, 5, 16-17, 22-23 and 25 of the specification were amended to capitalize the terminology of "SHODEX ASAHIPAK."

Claims 1 to 4 were objected to for the reason set forth at the middle of page 3 of the Office Action.

Claims 1 to 4 were amended to avoid the objection.

Claims 1 to 12 and 14 to 32 were rejected under 35 USC 112, first paragraph, for allegedly failing to comply with the enablement requirement for the reasons set forth beginning at the bottom of page 3 and continuing to the top of page 5 of the Office Action.

In reply to the 35 USC 112, first paragraph rejection, submitted concomitantly herewith is a DECLARATION OF MICROORGANISM DEPOSIT executed by Mr. Yukio SUGIMURA, dated March 9, 2004. Withdrawal of the rejection is therefore respectfully requested.

Claims 5 to 8 and 31 were rejected under 35 USC 112, first paragraph, for the reasons set forth beginning on page 5, line 4 and continuing to page 6, line 17 of the Office Action.

Claims 5 to 8 and 31 were amended to avoid the 35 USC 112, first paragraph rejection, by including the features of claims 9 to 12 and 32, respectively (claims 9 to 12 and 32 were not included in the rejection).

Claims 18 to 29 were rejected under 35 USC 102, first paragraph, for alleged lack of enablement for the reasons set forth beginning at the bottom of page 6 and continuing to the bottom of page 9 of the Office Action.

Claims 18, 21, 24 and 27 were amended hereinabove to recite specific infectious fungal diseases which are set forth in the last paragraph on page 28 of the specification. Some of such diseases are the subject of testing in the specification (see Test Example 1 on pages 25 and 26 of the specification).

Furthermore, claims 18, 21, 24 and 27 were amended to delete "or preventing." Thus all the method claims are directed only to "treating."

The Examiner is apparently trying to limit applicants only to their working examples and this is improper. See In re Anderson, 176 USPQ 331, 333 (CCPA, 1973), where the Court held as follows:

"we do not regard §112, first paragraph, as requiring a specific example of everything within the scope of a broad claim...What the Patent Office is here apparently attempting is to limit all claims to the specific examples, notwithstanding the disclosure of a broader invention. This it may not do."

Further support for such proposition is found in In re Kamal and Rogier, 158 USPQ 320 (CCPA, 1968). Quoting from In re Grimme, Keil, and Schmitz, 124 USPQ 499, 502 (CCPA, 1960), the Court stated as follows:

"It is manifestly impracticable for an applicant who discloses a generic invention to give an example of every species falling

within it, or even to name every such species. it is sufficient if the disclosure teaches those skilled in the art what the invention is and how to practice it."

Indeed, examples per se are not required to satisfy the requirements of 35 U.S.C. 112, first paragraph. See In re Strahilevitz, 212 USPQ 561, 562-563 (CCPA, 1982); In re Stephens, 188 USPQ 659, 660-662 (CCPA, 1976); In re Borokowski, 164 USPQ 642, 645-646 (CCPA, 1970); In re Gay, 135 USPQ 311, 316 (CCPA, 1962).

The Court held in In re Robins, 166 USPQ 552, 555-556 (CCPA, 1970) that working examples are only one means of satisfying the enablement requirement of 35 U.S.C. 112, and that the mere listing of specific compounds, chemicals, solvents, cross-linking agents, etc., in the specification would in most cases provide suitable evidence of enablement equivalent to specific working examples utilizing each of the various components. In this regard, please see the listing of *Penicillium* species on page 9, line 10 to page 10, line 1 of the specification.

The disclosure as set forth by the applicants in the application must be given the presumption of correctness and operativeness by the Patent and Trademark Office. The only relevant concern of the Patent and Trademark Office is the truth of the assertions in the application. In any event, the burden is on the Patent and Trademark Office whenever a rejection is made for lack of enablement under Section 112. The Examiner must

explain why she doubts the truth or accuracy of the statements in a supporting disclosure to which she objects. She must back up such assertions with acceptable evidence or reasoning which contradicts applicants' contentions. See, for example, In re Marzocchi, 169 USPQ 367, 369-370 (CCPA, 1967) and In re Bowen, 181 USPQ 48, 50-52 (CCPA, 1974).

It is respectfully submitted that the Examiner in the case at hand has not carried her burden of showing the applicants' specification to be untrue or inaccurate.

It should be further noted that only those skilled in the art must be enabled, not the general public. In re Storrs, 114 USPQ 293, 296-297 (CCPA, 1957).

Claims 2, 4 and 30 were rejected under 35 USC 112, second paragraph, for the reasons set forth in the first paragraph on page 10 of the Office Action.

Claims 2, 4 and 30 were amended to avoid the 35 USC 112, second paragraph rejection.

It is respectfully submitted that the specification and present claims meet all the requirements of 35 USC 112.

Enclosed is a check for \$18 in payment of one additional claim.

Reconsideration is requested. Allowance is solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,



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Encs.: (1) DECLARATION OF MICROORGANISM DEPOSIT
of Mr. Yukio SUGIMURA dated March 9, 2004

(2) Check for \$18